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EXAMINER

DUONG, THOMAS

ART UNIT PAPER NUMBER

2145

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,039

Applicant(s)

KATSUDA, TAKEO

Examiner

Thomas Duong

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-31 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-31 and 37-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the applicants Amendment filed on September 1, 2006. *Claims 14-47* are presented for further consideration and examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. *Claims 14-31 and 37-47* are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (US006421707B1).
4. With regard to *claims 15 and 37-43*, Miller discloses,
 - *an E-mail receiving device (service controller 713) receiving E-mail addressed to a portable terminal unit;* (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)Miller teaches of “[*allowing*] the selective retrieval and formatting of messages sent to a mobile subscriber” (Miller, col.6, lines 26-27). Miller discloses “the

present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones” (Miller, col.1, lines 44-46).

Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device; (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)*

Miller discloses, *“importantly, the output need not be a ‘message’ but could simply be notification that a message has been received” (Miller, col.3, lines 34-36).* Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller’s environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.

- *an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit; (Miller, col.1, lines 52-55; col.9, lines 41-46)*

Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.

- *a location information acquiring device acquiring location information of said portable acquiring device; (Miller, col.2, lines 58-64; col.4, lines 40-60; col.5, lines 1-7)*

Miller teaches of step of locating the mobile subscriber *"according to the rules he [has] previously established (or defaulted to, as appropriate)"* (Miller, col.5, lines 2-3). According to Miller, *"the ability for a user (recipient) to define a set of rules that determine how/when messages and their notification are to be treated ... such as a permanent rule (SMS notification to Thomas' handset) and a vacation rule (e.g., hold messages but notify Thomas at his hotel telephone), ... etc., are easily envisioned and implemented as appropriate"* (Miller, col.4, lines 49-60). In addition to the established rules, the fact that the message was delivered to the user via the wireless device is evidence that the user was located. When the user receives the message notifying of the impending e-mail and attachments, the user can choose the appropriate outputting device. In another embodiment, Miller allows for the automatic delivery of the attachment to the user based on the user's profile. Hence, Miller describes a method of locating the subscriber via established rules, in addition to the actual wireless device, and determining the appropriate outputting device to which the notification message is directed.

- *a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device;* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.4, lines 40-60; col.5, lines 1-7, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

Furthermore, Miller teaches of step of locating the mobile subscriber *"according to the rules he [has] previously established (or defaulted to, as appropriate)"* (Miller, col.5, lines 2-3). According to Miller, *"the ability for a user (recipient) to define a set of rules that determine how/when messages and their notification are to be treated ... such as a permanent rule (SMS notification to Thomas' handset) and a vacation rule (e.g., hold messages but notify Thomas at his hotel telephone), ... etc., are easily envisioned and implemented as appropriate"* (Miller, col.4, lines 49-60). Hence, Miller describes a method of locating the subscriber via established rules and determining the appropriate outputting device to which the notification message is directed.

- *a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference. According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

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- *a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device. (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)*

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

5. With regard to claim 16, Miller discloses,

- *wherein said E-mail preparing device prepares the receipt notice E-mail based on the content of a main text portion of the E-mail received by the E-mail receiving device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; fig.4 (g, h))*

Miller teaches of an environment where an email addressed to an addressee (i.e. subscriber) from the Internet is received at the service controller and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text.

6. With regard to claims 17-19, Miller discloses,

- *wherein said E-mail preparing device prepares the receipt notice E-mail by removing an attachment file portion of the E-mail received by the E-mail receiving*

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device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

Miller teaches of an environment where an email addressed to an addressee (i.e. subscriber) from the Internet is received at the service controller and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text. Miller shows in figures 4(i) and 4(m) that the attachments are listed separately to allow the subscriber the ability to retrieve it if desired after converting the attachment to the appropriate format.

- *wherein said data transmitting device transmits data corresponding to the attachment file portion of the E-mail received by the E-mail receiving device.*
(Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))
- *further comprising a converting device converting the attachment file portion of the E-mail received by the E-mail receiving device into data of a format acceptable to the image output device; wherein, said data transmitting device transmits the data after the conversion by said converting device.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

7. With regard to claims 20-21, Miller discloses,

- *wherein said data transmitting device transmits the data corresponding to an attachment file portion of the E-mail received by the E-mail receiving device.*

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(Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

- *wherein said data transmitting device transmits the data corresponding to the entire portion of the E-mail received by the E-mail receiving device.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

8. With regard to claims 22-25, and 28-29, Miller discloses,

- *wherein said selecting device selects image output devices within a certain distance from said destination.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

Miller teaches of a step of listing the available retrieval methods and allowing the subscriber to choose the desired delivery method.

- *wherein said selecting device selects an image output device closest from said destination.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))
- *wherein said selecting device includes:*
 - *a memory device storing location information of multiple image output devices; and*
 - *a search device searching image output devices suitable for the location information acquired by said location information acquiring device from multiple image output devices whose location information is stored in said memory device.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

- *wherein said selecting device includes:*
 - *a list preparing device preparing a list of image output devices within a certain distance from said portable terminal unit;*
 - *a list transmitting device transmitting the list prepared by said list preparing device to said portable terminal unit; and*
 - *a selection instruction receiving device receiving an instruction specifying one of the image output devices in the list. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

9. With regard to claims 26-27 and 30, Miller discloses,

- *wherein said data transmitting device transmits the data to an image output device specified by an IP address. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

Miller teaches of a plurality of delivery methods such as email, fax, messaging, voice, etc. Alternative methods of delivering the data include the Internet, printer, display, etc.
- *wherein said data transmitting device transmits the data to an image output device specified by a telephone number. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*
- *wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a printer. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

10. With regard to claims 14, 31, and 44-46, Miller discloses,

- *an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit; (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)*

Miller teaches of “[allowing] the selective retrieval and formatting of messages sent to a mobile subscriber” (Miller, col.6, lines 26-27). Miller discloses “the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones” (Miller, col.1, lines 44-46).

Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail; (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)*

Miller discloses, “importantly, the output need not be a ‘message’ but could simply be notification that a message has been received” (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller’s environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.

- *an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices; (Miller, col.1, lines 47-58; col.2, lines 58-64; col.4, line 40 - col.6, line 40; col.9, lines 40-46)*

Miller discloses, *"the present invention is directed to a method of providing wireless, multimedia communications service within a telecommunications network whereby a multimedia message may be received by the network and selectively delivered to a subscriber of the wireless service"* (Miller, col.1, lines 48-52). Hence, Miller teaches of a telecommunication system that is capable of delivering messages (i.e., Applicant's E-mail) to the subscriber of the wireless service *"via known wireless personal communications devices, i.e., cellular phones"* (Miller, col.1, lines 46-47) (i.e., Applicant's portable terminal unit). In addition, Miller discloses, *"upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network"* (Miller, col.1, lines 48-58). Hence, Miller teaches of the telecommunication system notifying the subscriber that the system received a message intended for the subscriber (i.e., Applicant's receipt notice E-mail) and delivering the message and its attachments to the subscriber based on the delivery option that the subscriber specified by the network. Miller discloses, *"if Thomas desired to retrieve more of the component parts of the e-mail, he could for example, chose to retrieve the plain text attachment as shown in FIG. 4(m)"*

(Miller, col.5, lines 60-62). In addition, Miller discloses, *"as you may recall, there were other parts of the original e-mail message that Thomas received, and in particular, a graphics file. With reference not tot FIG. 4(p), Thomas can select that part of the e-mail message as well through the numeric keypad 413. Then, as shown in FIG. 4(q), he selects an appropriate retrieval method, in this case facsimile. Finally, as shown in FIG. 4(r), Thomas enters a destination fax # to which the graphics file is to be sent in facsimile format"* (Miller, col.6, lines 9-16).

Hence, Miller teaches of the telecommunication system providing the subscriber with the possible image output methods (e.g., the display screen 412 and the facsimile) for retrieving the attachments in the message sent to the subscriber via the wireless personal communications handset 411.

- *an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;* (Miller, col.5, lines 35-49)

Miller teaches of a step where the subscriber specifies the desired method of retrieval of the email as well as the attachments.

- *a converting device converting the attachment file portion into data of a format acceptable to the image output device; and* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; fig.4 (g, h, i); fig.4 (m))

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the Internet and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text. Miller shows in figures 4(i) and 4(m) that the attachments

are listed separately to allow the subscriber the ability to retrieve it if desired after converting the attachment to the appropriate format.

- *a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; fig.4 (g, h, i); fig.4 (m))

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the Internet and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text. Miller shows in figures 4(i) and 4(m) that the attachments are listed separately to allow the subscriber the ability to retrieve it if desired after converting the attachment to the appropriate format.

11. With regard to claim 47, Miller discloses,

- *wherein said selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.4, lines 40-60; col.5, lines 1-7, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

Furthermore, Miller teaches of step of locating the mobile subscriber *"according to the rules he [has] previously established (or defaulted to, as appropriate)"* (Miller, col.5, lines 2-3). According to Miller, *"the ability for a user (recipient) to define a set of rules that determine how/when messages and their notification are to be treated ... such as a permanent rule (SMS notification to Thomas' handset) and a vacation rule (e.g., hold messages but notify Thomas at his hotel telephone), ... etc., are easily envisioned and implemented as appropriate"* (Miller, col.4, lines 49-60). In another embodiment, Miller allows for the automatic delivery of the attachment to the user based on the user's profile. Hence, Miller describes a method of locating the subscriber via established rules and determining the appropriate outputting device to which the notification message is directed.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
13. Claims 14-31 and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US006421707B1) and in view of Theimer et al. (US005493692A).
14. With regard to claims 14-15, 31, and 37-46, Miller discloses,

- *an E-mail receiving device (service controller 713) receiving E-mail addressed to a portable terminal unit; (Miller, col.1, lines 41-51, lines 54-58; col.3, lines 33-38; col.6, lines 25-40; col.9, lines 24-28; fig.7)*

Miller teaches of “[allowing] the selective retrieval and formatting of messages sent to a mobile subscriber” (Miller, col.6, lines 26-27). Miller discloses “the present invention permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices, i.e., cellular telephones” (Miller, col.1, lines 44-46).

Hence, Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller and a receipt notification is selectively generated and delivered to the mobile subscriber.

- *an E-mail preparing device preparing receipt notice E-mail based on the E-mail received by said E-mail receiving device; (Miller, col.1, lines 52-55; col.3, lines 33-38; col.4, lines 40-43; col.9, lines 41-46)*

Miller discloses, “importantly, the output need not be a ‘message’ but could simply be notification that a message has been received” (Miller, col.3, lines 34-36). Hence, Miller teaches of an environment where a receipt notification is generated and delivered to the mobile subscriber in response to receiving a message. In addition, Miller’s environment allows the subscriber the ability to customize the message receipt notification through the use of a user-specific agent.

- *an E-mail transmitting device transmitting the receipt notice E-mail prepared by said E-mail preparing device to said portable terminal unit; (Miller, col.1, lines 52-55; col.9, lines 41-46)*

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Miller teaches of an environment where a receipt notification is generated and delivered to the addressee.

- *a notifying device that sends an E-mail to said portable terminal unit containing a notification of the image output device selected by said selecting device; and* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

According to Miller, the *"delivery subsystem 160 handles the actual delivery of output of service complex 101. Importantly, the output need not be a 'message' but could simply be notification that a message has been received, [and that] ... the delivery subsystem 160 can handle a variety of output formats, voice/fax 162, short message 161, and e-mail 163"* (Miller, col.3, lines 33-38).

- *a data transmitting device transmitting at least a portion of the data of the E-mail received by the E-mail receiving device to the image output device selected by the selecting device.* (Miller, col.1, lines 47-58; col.2, lines 58-64; col.5, lines 35-49; col.6, lines 14-19; col.9, lines 40-46)

Miller teaches of an environment where an email addressed to a mobile subscriber is received at the service controller from the internet, a receipt notification is selectively generated and delivered to the addressee, the

addressee is located and finally the intended email is displayed to the subscriber or outputted to a device (i.e., facsimile) according to subscriber's preference.

Even though Miller discloses the locating and selecting steps as the Examiner explained in the 35 U.S.C. 102(e) rejection above, the Examiner will present another reference, Theimer (US005493692A), that clearly teaches the locating the subscriber device and selecting the appropriate output method base on the location of the mobile subscriber.

Theimer teaches,

- *a location information acquiring device acquiring location information of said portable terminal unit; (Theimer, col.8, lines 40-58; col.9, lines 7-20; col.24, lines 8-48; fig.16)*

Theimer teaches of an environment where a message is received at a portable terminal unit, the available delivery methods based on the location of the subscriber are detected, and delivering the data to the appropriate output or display device.

- *a selecting device selecting one of multiple image output devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device; and (Theimer, col.8, lines 40-58; col.9, lines 7-20; col.24, lines 8-48; fig.16)*

Theimer teaches of an environment where a message is received at a portable terminal unit, the available delivery methods based on the location of the subscriber are detected, and delivering the data to the appropriate output or display device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Theimer with the teachings of Miller to selectively deliver messages to a subscriber of the wireless service base on the available as well as appropriate output or display methods in proximity to the subscriber. According to Theimer, it is advantageous to *"provide a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate computing devices for particular actions, such as delivery of electronics messages, are selected based on the environment in proximity to the user in relation to the properties of the message"* (Theimer, col.4, lines 5-12).

15. With regard to claim 16, Miller and Theimer disclose,

- *wherein said E-mail preparing device prepares the receipt notice E-mail based on the content of a main text portion of the E-mail received by the E-mail receiving device.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; fig.4 (g, h))

Miller teaches of an environment where an email addressed to an addressee (i.e. subscriber) from the Internet is received at the service controller and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text.

16. With regard to claims 17-19, Miller and Theimer disclose,

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- *wherein said E-mail preparing device prepares the receipt notice E-mail by removing an attachment file portion of the E-mail received by the E-mail receiving device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

Miller teaches of an environment where an email addressed to an addressee (i.e. subscriber) from the Internet is received at the service controller and a receipt notification is selectively generated and delivered to the addressee.

Furthermore, Miller anticipates that the notification message may contain the body of the email text. Miller shows in figures 4(i) and 4(m) that the attachments are listed separately to allow the subscriber the ability to retrieve it if desired after converting the attachment to the appropriate format.

- *wherein said data transmitting device transmits data corresponding to the attachment file portion of the E-mail received by the E-mail receiving device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*
- *further comprising a converting device converting the attachment file portion of the E-mail received by the E-mail receiving device into data of a format acceptable to the image output device; wherein, said data transmitting device transmits the data after the conversion by said converting device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

17. With regard to claims 20-21, Miller and Theimer disclose,

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- *wherein said data transmitting device transmits the data corresponding to an attachment file portion of the E-mail received by the E-mail receiving device.*
(Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))
- *wherein said data transmitting device transmits the data corresponding to the entire portion of the E-mail received by the E-mail receiving device.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

18. With regard to claims 22-25, and 28-29, Miller and Theimer disclose,

- *wherein said selecting device selects image output devices within a certain distance from said destination.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

Miller teaches of a step of listing the available retrieval methods and allowing the subscriber to choose the desired delivery method.
- *wherein said selecting device selects an image output device closest from said destination.* (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))
- *wherein said selecting device includes:*
 - *a memory device storing location information of multiple image output devices; and*
 - *a search device searching image output devices suitable for the location information acquired by said location information acquiring device from multiple image output devices whose location information is stored in said*

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memory device. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

- *wherein said selecting device includes:*
 - *a list preparing device preparing a list of image output devices within a certain distance from said portable terminal unit;*
 - *a list transmitting device transmitting the list prepared by said list preparing device to said portable terminal unit; and*
 - *a selection instruction receiving device receiving an instruction specifying one of the image output devices in the list. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

19. With regard to claims 26-27 and 30, Miller and Theimer disclose,

- *wherein said data transmitting device transmits the data to an image output device specified by an IP address. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*

Miller teaches of a plurality of delivery methods such as email, fax, messaging, voice, etc. Alternative methods of delivering the data include the Internet, printer, display, etc.
- *wherein said data transmitting device transmits the data to an image output device specified by a telephone number. (Miller, col.1, lines 47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))*
- *wherein said data transmitting device transmits at least a portion of the data of the E-mail received by the E-mail receiving device to a printer. (Miller, col.1, lines*

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47-58; col.3, lines 33-38; col.5, lines 22-27; col.6, lines 9-19; fig.4 (g, h, i); fig.4 (m))

20. Claim 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US006421707B1), in view of Theimer et al. (US005493692A), and further in view of Glorikian (US006343317B1).

21. With regard to claim 47, Miller and Theimer disclose,

See *claim 15* rejection as detailed above.

However, Miller and Theimer do not explicitly disclose,

- *wherein said selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device.*

Glorikian teaches,

- *wherein said selecting device automatically selects one of said multiple image devices on the basis of the location information of said portable terminal unit acquired by said location information acquiring device.* (Glorikian, col.2, line 9 – col.3, line 3)

Glorikian teaches “*determining position of a computerized appliance by a position-determining system cooperating with the appliance; and retrieving information from the data repository and sending the retrieved information to the appliance, based at least in part on the position of the appliance*” (Glorikian, col.2, lines 42-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Glorikian with the teachings of Miller and Theimer to selectively deliver messages to a subscriber of the wireless service base on the available as well as appropriate output or display methods in proximity to the subscriber. According to Theimer, it is advantageous to *"provide a system in which the delivery of electronic messages to a particular user or users may be selective, depending upon the context or state of the user or users. Furthermore, appropriate computing devices for particular actions, such as delivery of electronics messages, are selected based on the environment in proximity to the user in relation to the properties of the message"* (Theimer, col.4, lines 5-12). Furthermore, according to Glorikian, recognized *"a need to narrowly focus information services to provide highly specialized information specific to needs of groups of individual clients, and automatically or semi-automatically provided to such clients"* (Glorikian, col.2, lines 3-6).

Response to Arguments

22. Applicant's arguments with respect to *claims 14, 31, and 44-46* have been considered but they are not persuasive.
23. With regard to *claims 14, 31, and 44-46*, the Applicant point out that:
- *The above cited portions of the Miller patent do not disclose or suggest an e-mail transmitting device transmitting to said portable terminal unit the receipt notice e-mail prepared by said e-mail preparing device and an e-mail identifying multiple prospective image output devices as recited in claim 14.*

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- *In making the rejection on pages 16-20 of the Office Action, the Examiner appears to be paraphrasing the limitations of the independent claims. By doing so, the Examiner has failed to address, for instance, in claim 14, the feature of an instruction receiving device receiving an e-mail including an instruction for specifying one of multiple image output devices. As stated above, the Miller patent neither discloses nor suggests such a feature.*

However, the Examiner finds that the Applicant's arguments are not persuasive because Miller discloses, *"the present invention is directed to a method of providing wireless, multimedia communications service within a telecommunications network whereby a multimedia message may be received by the network and selectively delivered to a subscriber of the wireless service"* (Miller, col.1, lines 48-52). Hence, Miller teaches of a telecommunication system that is capable of delivering messages (i.e., Applicant's E-mail) to the subscriber of the wireless service *"via known wireless personal communications devices, i.e., cellular phones"* (Miller, col.1, lines 46-47) (i.e., Applicant's portable terminal unit). In addition, Miller discloses, *"upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network"* (Miller, col.1, lines 48-58). Hence, Miller teaches of the telecommunication system notifying the subscriber that the system received a message intended for the subscriber (i.e., Applicant's receipt notice E-mail) and delivering the message and its attachments to the subscriber based on the delivery option that the subscriber specified by the network. Miller discloses, *"if Thomas*

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desired to retrieve more of the component parts of the e-mail, he could for example, chose to retrieve the plain text attachment as shown in FIG. 4(m)" (Miller, col.5, lines 60-62). In addition, Miller discloses, "as you may recall, there were other parts of the original e-mail message that Thomas received, and in particular, a graphics file.

With reference not tot FIG. 4(p), Thomas can select that part of the e-mail message as well through the numeric keypad 413. Then, as shown in FIG. 4(q), he selects an appropriate retrieval method, in this case facsimile. Finally, as shown in FIG. 4(r), Thomas enters a destination fax # to which the graphics file is to be sent in facsimile format" (Miller, col.6, lines 9-16). Hence, Miller teaches of the telecommunication system providing the subscriber with the possible image output methods (e.g., the display screen 412 and the facsimile) for retrieving the attachments in the message sent to the subscriber via the wireless personal communications handset 411.

24. Applicant's arguments with respect to *claims 15 and 37-43* have been considered but they are not persuasive.

25. With regard to claims 15 and 37-43, the Applicant point out that:

- *As for claims 15, and 37-43, as discussed in the Examiner's Interview, claim 15 recites the selection of one of the multiple output devices on the basis of the location information and the sending of an e-mail to the portable unit that contains a notification of the selected image output device. During the interview the Examiner agreed that these features, in combination with the other features recited in the claim, were not disclosed or suggested by the applied prior art.*

Applicant respectfully requests that the rejection under 35 U.S.C. §102(e) of claims 15 and 37-43 over the Miller patent be withdrawn.

However, the Examiner finds that the Applicant's arguments are not persuasive because Miller discloses, *"the present invention is directed to a method of providing wireless, multimedia communications service within a telecommunications network whereby a multimedia message may be received by the network and selectively delivered to a subscriber of the wireless service"* (Miller, col.1, lines 48-52). Hence, Miller teaches of a telecommunication system that is capable of delivering messages (i.e., Applicant's E-mail) to the subscriber of the wireless service *"via known wireless personal communications devices, i.e., cellular phones"* (Miller, col.1, lines 46-47) (i.e., Applicant's portable terminal unit). In addition, Miller discloses, *"upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber. The subscriber is then notified by the network of the message and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber to the network"* (Miller, col.1, lines 48-58). Hence, Miller teaches of the telecommunication system notifying the subscriber that the system received a message intended for the subscriber (i.e., Applicant's receipt notice E-mail) and delivering the message and its attachments to the subscriber based on the delivery option that the subscriber specified by the network. Miller discloses, *"if Thomas desired to retrieve more of the component parts of the e-mail, he could for example, chose to retrieve the plain text attachment as shown in FIG. 4(m)"* (Miller, col.5, lines 60-62). In addition, Miller discloses, *"as you may recall, there were other parts of the original e-mail message that Thomas received, and in particular, a graphics file.*

With reference not tot FIG. 4(p), Thomas can select that part of the e-mail message as well through the numeric keypad 413. Then, as shown in FIG. 4(q), he selects an appropriate retrieval method, in this case facsimile. Finally, as shown in FIG. 4(r), Thomas enters a destination fax # to which the graphics file is to be sent in facsimile format” (Miller, col.6, lines 9-16). Hence, Miller teaches of the telecommunication system providing the subscriber with the possible image output methods (e.g., the display screen 412 and the facsimile) for retrieving the attachments in the message sent to the subscriber via the wireless personal communications handset 411. Hence, Miller teaches that the plain text attachment can be retrieved via the display screen 412, which is an image output device to one of ordinary skill in the art. The screen display 412 is indeed an image output device that is local to the subscriber and is capable of displaying the plain text attachment of the message if specified by the subscriber upon the subscriber’s choosing.

26. With regard to claims 15 and 37-43, the Applicant point out that:

- *As for claims 15, and 37-43, as discussed in the Examiner's Interview, claim 15 recites the selection of one of the multiple output devices on the basis of the location information and the sending of an e-mail to the portable unit that contains a notification of the selected image output device. During the interview the Examiner agreed that these features, in combination with the other features recited in the claim, were not disclosed or suggested by the applied prior art. Applicant respectfully requests that the rejection under 35 U.S.C. §102(e) of claims 15 and 37-43 over the Miller patent be withdrawn.*

However, the Examiner finds that the Applicant's arguments are not persuasive because the Examiner merely agreed to carefully consider the Applicant's arguments and remarks with the filing of the response. Please refer to the Examiner's rebuttals presented above with regards to the Applicant's arguments.

Conclusion

27. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

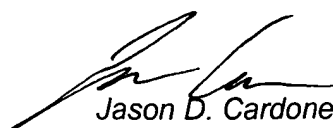
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on 571/272-3933. The fax phone numbers for the organization where this application or proceeding is assigned are 571/273-8300 for regular communications and 571/273-8300 for After Final communications.

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Thomas Duong (AU2145)

November 22, 2006

A handwritten signature in black ink, appearing to read 'Jason D. Cardone', is positioned above the printed name.

Jason D. Cardone

Supervisory PE (AU2145)